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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,561	11/07/2001	Guo-Bin Wang	11113/9	3657

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NEW YORK, NY 10004

EXAMINER
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BRUENJES, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/035,561

Applicant(s)

WANG ET AL.

Examiner

Christopher P Bruenjes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

#### ***Examiner Note***

1. Claims 1-30 in the present amendment are listed as withdrawn. However, those claims were cancelled in the response to the restriction requirement filed March 3, 2003 and should be listed as such in any subsequent amendments filed.

#### ***REPEATED REJECTIONS***

2. The 35 U.S.C. 102 rejections of claims 31-35 as anticipated by Fydeler are repeated for the reasons set forth in the previous Paper #5, Page 4 Paragraph 4.

Regarding the newly added limitations to claims 31 and 35, Fydeler teaches the medium comprises at least one salt (col.3, 1.4-10). Fydeler teaches that the initiation of the graft-polymerization is initiated by heat and chemical initiators such as organic peroxides, which is an organic free radical initiator (col.3, 1.15-17). Furthermore, the limitation "thermally initiated" is a process limitation and receives little patentable weight in an article claim. Fydeler teaches the same materials being grafted together and the use of the same photoinitiators taught in the instant specification as organic free radical initiators used to in the graft polymerization.

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Therefore, structurally Fydelor teaches all of the claimed limitations and the fact that the organic free radical initiator present is irradiated by UV or visible light rather than heat is not germane to the patentability of the product, because the same product can be formed by multiple methods, absent the showing of unexpected results. Fydelor teaches that the graft polymerization is present on the surface of the substrate and therefore the initiator must be on the surface. The limitations "prior to thermal initiation" and "at the time of thermal initiation" are process limitations and receive little patentable weight in an article claim. The presence of the organic free radical initiator on the surface of the substrate is a structural limitation, but the timing of when the initiator is placed on the surface is not germane to patentability of an article claim.

3. The 35 U.S.C. 102 rejections of claims 31-35 as anticipated by Michal are repeated for the reasons set forth in the previous Office Action mailed December 29, 2003, Pages 3-4 Paragraph 5.

Regarding the newly added limitations to claims 31 and 35, Michal teaches the medium comprises at least one salt (col.5, 1.20-22). Michal teaches that the initiation of the graft-polymerization is initiated photoinitiators, which are organic

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free radical initiators, and are irradiated with UV or visible light, which inherently will produce at least a slight thermal increase (col.11, 1.11-15). Furthermore, the limitation "thermally initiated" is a process limitation and receives little patentable weight in an article claim. Michal teaches the same materials being grafted together and the use of the same photoinitiators taught in the instant specification as organic free radical initiators used to in the graft polymerization. Therefore, structurally Michal teaches all of the claimed limitations and the fact that the organic free radical initiator present is irradiated by UV or visible light rather than heat is not germane to the patentability of the product, because the same product can be formed by multiple methods, absent the showing of unexpected results. Michal teaches that the graft polymerization is present on the surface of the substrate and therefore the initiator must be on the surface. The limitations "prior to thermal initiation" and "at the time of thermal initiation" are process limitations and receive little patentable weight in an article claim. The presence of the organic free radical initiator on the surface of the substrate is a structural limitation, but the timing of when the initiator is placed on the surface is not germane to patentability of an article claim.

*ANSWERS TO APPLICANT'S ARGUMENTS*

4. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 31-35 as anticipated by Fydelor have been fully considered but they are not persuasive.

In response to Applicant's argument that Fydelor fails to teach that the organic free radical initiator is a thermally activated initiator present on the surface of the substrate at the time of thermally induced initiation, these limitations are process limitations and receive little patentable weight in an article claim. Fydelor teaches the same structure as the claimed invention in that Fydelor teaches a medical device comprising a substrate, a plurality of monomer molecules directly graft polymerized onto the surface having reversed hydrophilicity and comprising a salt, and an organic free radical initiator on the surface of the substrate to initiate the graft polymerization. Whether the initiator is activated thermally or by other activation means or at which step in the process of forming the device that the initiator was applied to the surface of the substrate, does not substantially change the end product result claimed. Articles are defined by their structure alone. Although process limitations are allowed in article claims, the process itself is not germane, only the

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final product produced by that process. Therefore, in light of the showing by the Examiner that structurally the claimed device and the Fydolor device are equivalent, the burden is shifted to the applicant to provide evidence of how the different method limitations claimed would form a materially different device from the Fydolor device.

5. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 31-35 as anticipated by Michal have been fully considered but they are not persuasive.

In response to Applicant's argument that Michal fails to teach that the organic free radical initiator is a thermally activated initiator present on the surface of the substrate at the time of thermally induced initiation, these limitations are process limitations and receive little patentable weight in an article claim. Michal teaches the same structure as the claimed invention in that Michal teaches a medical device comprising a substrate, a plurality of monomer molecules directly graft polymerized onto the surface having reversed hydrophilicity and comprising a salt, and an organic free radical initiator on the surface of the substrate to initiate the graft polymerization. Whether the initiator is activated thermally or by other activation means or at which step in the process of forming the

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device that the initiator was applied to the surface of the substrate, does not substantially change the end product result claimed. Articles are defined by their structure alone. Although process limitations are allowed in article claims, the process itself is not germane, only the final product produced by that process. Therefore, in light of the showing by the Examiner that structurally the claimed device and the Michal device are equivalent, the burden is shifted to the applicant to provide evidence of how the different method limitations claimed would form a materially different device from the Michal device.

#### **Conclusion**

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes  
Examiner  
Art Unit 1772

CPB  
June 29, 2005

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER

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6/30/05